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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,936	05/16/2006	Kenzo Takahashi	47234-5003	4204
55694 7590 11/26/2008 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209			EXAMINER GWARTNEY, ELIZABETH A	
			ART UNIT 1794	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/560,936

## Applicant(s)

TAKAHASHI ET AL.

## Examiner

Elizabeth Gwartney

## Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-152)
- Paper No(s)/Mail Date 20051215/20061128/20070921
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 3-7 and 9-10, the recitation "removing *most* of the particles of 1  $\mu$ m or more in diameter" renders the claims indefinite. It is unclear what quantity or particles or particle size distribution "most of the particles" represents.

The term "fine" in claims 1, 3-4, 6 and 9-10 is a relative term which renders the claim indefinite. The term "fine" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear what particle size "fine" encompasses.

The term "ultrafine" in claims 1, 5, 7-8 and 11 is a relative term which renders the claim indefinite. The term "ultrafine" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear what particle size "ultrafine" encompasses.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yoshiyuki et al. (JP 11-276074- machine translation).

Regarding claims 1-4, Yoshiyuki et al. disclose a fine ground tea dispersion and a tea beverage produced by removing most of the particles less than 1 um in diameter (Abstract, [0014], [0018]).

Although Yoshiyuki et al. does not disclose grinding the tea , it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed process and given that Yoshiyuki et al. meets the requirements of the claimed product, Toshio clearly meet the requirements of present claim 1.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(e) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yutaka et al. (JP 08-116881 – Abstract only) in view of Yoshiyuki et al. (JP 11-276074 – machine translation, PAJ).

Regarding claims 1 and 3, Yutaka et al. disclose a fine powder tea having  $\leq 10\ \mu\text{m}$  average particle diameter produced by powdering (i.e. grinding) a tea raw material and subjecting the preliminarily powdered tea to wet pulverization by a high pressure homogenizer (Abstract). Yutaka et al. also disclose a tea beverage made from the fine powder tea (Abstract).

Yutaka et al. fails to disclose removing most of the particles of  $1\ \mu\text{m}$  or more in diameter.

Yoshiyuki et al. teach a tea beverage made from a fine powder tea that has excellent flavor and no turbidity or dregs (Abstract). Yoshiyuki et al. teach that the tea beverage is produced by centrifuging a fine powdery tea dispersion to remove larger particles and leave particles of  $1\ \mu\text{m}$  or less in diameter (Abstract, [0010]).

Yutaka et al. and Yoshiyuki et al. are combinable because they are concerned with the same field of endeavor, namely, beverages made with fine powdery tea. It would have been obvious to one of ordinary skill in the art to have removed particles of  $1\ \mu\text{m}$  or more in diameter, as taught by Yoshiyuki et al. in the fine powdery tea dispersion of Yutaka et al. for the purpose of making a tea beverage with excellent flavor and clarity.

Regarding claim 2 modified Yutaka et al. disclose all of the claim limitations as set forth above. Yutaka et al. disclose that the ultrafine tea is included as a tea component in a tea drink, food, or drink containing the ultrafine powder tea (Abstract).

Regarding claim 4, Yutaka et al. disclose a tea beverage produced by powdering (i.e. grinding) a tea raw material and subjecting the preliminarily powdered tea to wet pulverization by a high pressure homogenizer (Abstract).

Yutaka et al. fails to disclose removing most of the particles of 1  $\mu\text{m}$  or more in diameter.

Yoshiyuki et al. teach a tea beverage made from a fine powder tea that has excellent flavor and no turbidity or dregs (Abstract). Yoshiyuki teach preparing an extract with a fine powdery tea and centrifuging the extract to remove larger particles and leave particles of 1  $\mu\text{m}$  or less in diameter (Abstract, [0010]).

Yutaka et al. and Yoshiyuki et al. are combinable because they are concerned with the same field of endeavor, namely, beverages made with fine powdery tea. It would have been obvious to one of ordinary skill in the art to have removed particles of 1  $\mu\text{m}$  or more in diameter, as taught by Yoshiyuki et al. in the fine powdery tea dispersion of Yutaka et al. for the purpose of making a tea beverage with excellent flavor and clarity.

Regarding claims 5-7, Yutaka et al. disclose a method for producing a fine powder tea dispersion, comprising powdering (i.e. grinding) a tea raw material and subjecting the preliminarily powdered tea to wet pulverization by a high pressure homogenizer (Abstract).

Yutaka et al. fails to disclose removing most of the particles of 1  $\mu\text{m}$  or more in diameter.

Yoshiyuki et al. teach a tea beverage made from a fine powder tea that has excellent flavor and no turbidity or dregs (Abstract). Yoshiyuki teach preparing an extract with a fine powdery tea and centrifuging the extract to remove larger particles and leave particles of 1  $\mu\text{m}$  or less in diameter (Abstract, [0010]).

Yutaka et al. and Yoshiyuki et al. are combinable because they are concerned with the same field of endeavor, namely, beverages made with fine powdery tea. It would have been obvious to one of ordinary skill in the art to have prepared an extract with the fine powder tea and removed particles of 1  $\mu\text{m}$  or more in diameter, as taught by Yoshiyuki et al. in the fine powdery tea dispersion of Yutaka et al. for the purpose of making a tea beverage with excellent flavor and clarity.

Regarding claim 8, modified Yutaka et al. disclose all of the claim limitations as set forth above. Yutaka et al. also disclose a method for making a food or beverage by including as a tea component, the ultrafine ground tea dispersion in a tea drink, food, or drink containing the ultrafine powder tea (Abstract).

Regarding claim 9, Yutaka et al. disclose a method for producing a beverage comprising powdering (i.e. grinding) a tea raw material and subjecting the preliminarily powdered tea to wet pulverization by a high pressure homogenizer (Abstract). Yutaka et al. also disclose including the fine powdered tea in a beverage (Abstract).

Yutaka et al. fails to disclose removing most of the particles of 1  $\mu\text{m}$  or more in diameter.

Yoshiyuki et al. teach a tea beverage made from a fine powder tea that has excellent flavor and no turbidity or dregs (Abstract). Yoshiyuki teach preparing an extract with a fine powdery tea and centrifuging the extract to remove larger particles and leave particles of 1  $\mu\text{m}$  or less in diameter (Abstract, [0010]).

Yutaka et al. and Yoshiyuki et al. are combinable because they are concerned with the same field of endeavor, namely, beverages made with fine powdery tea. It would have been



obvious to one of ordinary skill in the art to have removed particles of 1  $\mu\text{m}$  or more in diameter, as taught by Yoshiyuki et al. in the fine powdery tea dispersion of Yutaka et al. for the purpose of making a tea beverage with excellent flavor and clarity.

Regarding claim 10, Yutaka et al. disclose a method for producing a beverage comprising powdering (i.e. grinding) a tea raw material and subjecting the preliminarily powdered tea to wet pulverization by a high pressure homogenizer (Abstract).

Yutaka et al. fails to disclose blending the fine powder tea with a tea extract and removing most of the particles of 1  $\mu\text{m}$  or more in diameter.

Yoshiyuki et al. teach a tea beverage made from a fine powder tea that has excellent flavor and no turbidity or dregs (Abstract). Yoshiyuki teach preparing an extract with a fine powdery tea and centrifuging the extract to remove larger particles and leave particles of 1  $\mu\text{m}$  or less in diameter (Abstract, [0010]).

Yutaka et al. and Yoshiyuki et al. are combinable because they are concerned with the same field of endeavor, namely, beverages made with fine powdery tea. It would have been obvious to one of ordinary skill in the art to have prepared an extract with the fine powder tea and removed particles of 1  $\mu\text{m}$  or more in diameter, as taught by Yoshiyuki et al. in the fine powdery tea dispersion of Yutaka et al. for the purpose of making a tea beverage with excellent flavor and clarity.

Regarding claim 12, modified Yutaka et al. disclose all of the claim limitations as set forth above. Yutaka et al. also disclose a tea beverage (Abstract).

Regarding claim 13, modified Yutaka et al. disclose all of the claim limitations as set forth above. Given that modified Yutaka et al. disclose a tea beverage identical to that presently

claimed and that does not generate nonuniform turbidity and dregs, it is clear that the tea beverage would intrinsically have a turbidity in the range claimed.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yutaka et al. (JP 08-116881 – Abstract only) in view of Yoshiyuki et al. (JP 11-276074 – machine translation, PAJ) as applied to claim 1 above, and further in view of Fu et al. (US 5,827,560).

Regarding claim 10, modified Yutaka et al. disclose all of the claim limitations as set forth above. However, the references fail to disclose blending the ultrafine ground tea dispersion according to claim 1 with tea extract to produce a tea beverage.

Fu et al. teach a tea extract containing soluble tannins having good color (Abstract). Further, Fu et al. teach a diluted tea beverage made from the tea extract (Examples 1-7).

Yataka et al, Yoshiyuki et al., and Fu et al. are combinable because they are concerned with the same field of endeavor, namely, production of tea products. Given that Yataka et al. disclose a drink containing the ultrafine powder and Fu et al. teach a diluted tea drink made from a tea extract, it would have been obvious to one of ordinary skill in the art at the time of the invention to have blended the diluted extract, taught by Fu et al. with the ultrafine powder of modified Yataka et al. for the purpose of producing a tea beverage with good color from tannin.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Gwartney whose telephone number is (571) 270-3874.

The examiner can normally be reached on Monday - Thursday; 7:30AM - 5:00PM EST, working alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. G./  
Examiner, Art Unit 1794

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794